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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,564	02/05/2002	Emad S. Alnemri	480140.434C2	8175

500 7590 09/16/2005

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EXAMINER

NICKOL, GARY B

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/068,564

**Applicant(s)**

ALNEMRI ET AL.

**Examiner**

Gary B. Nickol Ph.D.

**Art Unit**

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 56-60, 69 and 70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56-60, and 69-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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Re: Alnemri *et al.*

Date of priority: 11/06/1998

***Response to Amendment***

The Response filed 07-19-2005 in response to the Office Action of 04-19-2005 is acknowledged and has been entered.

Claims 56-60, and 69-70 are currently under consideration.

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.**

Claims 56-60, and 69-70 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rasmussen *et al.* (Electrophoresis, Vol. 13, pages 960-969, 1992) for the reasons of record.

Applicants reiterate (Response, page 4) that the reference fails to provide the requisite teaching or suggestion of the desirability of the claimed invention. Applicants further submit that the Examiner has not demonstrated any motivation to combine the cited reference to achieve the claimed invention. These arguments, being highly similar to applicant's previous arguments, are not found persuasive for the reasons of record.

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Applicants further disagree (Response, page 5) with the rationale of applying *Ex parte Erlich* (see Action mailed 04-19-2005) and submit that the case law clearly holds that in order for an antibody to be obvious in light of the polypeptide it specifically binds, “there must still be a demonstrated motivation to produce such an antibody”. Applicants argue (Response, bridging pages 5-6) that this is clearly set forth in *Ex parte Erlich* because the antigen (human fibroblast interferon) was a known antigen and the prior art (Rasmussen *et al.*) in this case provided absolutely no teaching or suggestion that the sequences identified have any clinical relevance or represent important clinical targets. This argument has been carefully considered but is not found persuasive because, as set forth previously, a clear objective for producing antibodies against a described polypeptide is not necessary. It is **conventional** in the art to generate antibodies following the cloning of any gene. Moreover, since 1984, it has been customary for any group working on a macromolecule to both clone the genes coding for it and make monoclonal antibodies to it without a clear objective for their application, (Campbell, A.M. previously cited). Thus, it would appear that applicants are simply arguing the opposite of that which was previously presented by the Examiner in the previous action. Thus, applicant’s arguments have not been found persuasive, and the rejection is maintained.

No claim is allowed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 571-272-0835. The examiner can normally be reached on M-Th, 8:30-5:30; alternate Fri., 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary B. Nickol Ph.D.  
Primary Examiner  
Art Unit 1642

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GBN

A handwritten signature in black ink, appearing to read "Gary B. Nickol". The signature is written in a cursive, flowing style.

**GARY B. NICKOL, PH.D.**  
**PRIMARY EXAMINER**